



[3510-16-P]

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2014-0012]

RIN 0651-AC95

Changes to Facilitate Applicant's Authorization of Access to Unpublished U.S.

Patent Applications by Foreign Intellectual Property Offices

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The electronic sharing of information and documents between intellectual property (IP) offices is critical for increasing the efficiency and quality of patent examination worldwide. Current examples of this sharing include the priority document exchange (PDX) program and the program by which U.S. search results are delivered to the European Patent Office (EPO). In support of electronic file sharing, the United States Patent and Trademark Office (Office) is revising its rules of practice to include a specific provision by which an applicant can authorize the Office to give a foreign IP office that is a party to an agreement with the Office access to all or part of the file contents of an

unpublished U.S. patent application in order to satisfy a requirement for information imposed on a counterpart application filed with the foreign IP office. Previously, for unpublished U.S. patent applications, applicants followed one regulatory provision to provide the Office with authorization for a foreign IP office to access an application-as-filed and followed another regulatory provision to provide the Office with authorization to share the file contents with a foreign IP office. The final rule changes consolidate the specific provisions of the regulations by which applicants give the Office authority to provide a foreign IP office with access to an application in order to satisfy a requirement for information of the foreign IP office. The Office is also revising the rules of practice to indicate there is no fee for providing a foreign IP office with an electronic copy of an application-as-filed or an electronic copy of file contents pursuant to a bilateral or multilateral agreement. Additionally, along with changes to the application data sheet (ADS) form, the final rule changes simplify the process for how applicants provide the Office with the required authorization, thereby reducing the resources applicants must expend to comply with these foreign IP office requirements, and enhance the quality of patent examination.

DATES: Effective Date: The changes in this final rule are effective on November 30, 2015. The revised ADS form (PTO/AIA/14) will be posted on the Office's Web site on or before the effective date.

Applicability Date: The changes to 37 CFR 1.14(h) apply to all patent applications filed before November 30, 2015, and to all patent applications filed on or after November 30, 2015.

FOR FURTHER INFORMATION CONTACT: Susy Tsang-Foster, Senior Legal Advisor (telephone (571) 272-7711; electronic mail message (susy.tsang-foster@uspto.gov)) or Joseph F. Weiss, Jr., Senior Legal Advisor (telephone (571) 272-2259; electronic mail message (joseph.weiss@uspto.gov)), of the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION:

Executive Summary: Purpose: 37 CFR 1.14(h) regulates access by foreign IP offices to U.S. applications. Formerly, 37 CFR 1.14(h) contained only a specific provision by which an applicant could authorize the Office to give a foreign IP office participating with the Office in a bilateral or multilateral priority document exchange agreement access to a U.S. application-as-filed. 37 CFR 1.14(h) is now expanded to also include a specific provision by which, under certain circumstances, an applicant can authorize the Office to give a foreign IP office access to all or part of the file contents of a U.S. patent application in order to satisfy the foreign IP office's requirement for information.

Summary of Major Provisions: This final rule primarily provides a specific provision by which an applicant can authorize the Office to provide a foreign IP office access to all or part of the file contents of a U.S. patent application where the foreign IP office has imposed a requirement for information on a counterpart application filed with that office and is a party to a bilateral or multilateral agreement with the Office to provide the required information from the U.S. application.

This final rule also revises the rules of practice to indicate that there is no fee for providing a foreign IP office with an electronic copy of an application-as-filed or an electronic copy of file contents pursuant to a bilateral or multilateral agreement.

Previously, the regulations only indicated that there was no fee for providing a foreign IP office with a copy of an application-as-filed pursuant to a priority document exchange agreement.

Additionally, the Office is revising the ADS form (PTO/AIA/14) as well as the PTO/SB/39 and PTO/SB/69 forms to facilitate applicant's authorization of access to unpublished U.S. applications by foreign IP offices.

Costs and Benefits: This rulemaking is not economically significant as that term is defined in Executive Order 12866 (Sept. 30, 1993).

Background: The electronic sharing of information and documents between IP offices is critical for increasing the efficiency and quality of patent examination worldwide. The electronic sharing of documents between IP offices also benefits applicants by reducing the cost of ordering documents from one IP office and then filing them in another IP office where a counterpart application has been filed.

Due to the confidential nature of unpublished U.S. patent applications, set forth in 35 U.S.C. 122, an applicant must provide the Office with written authority in accordance with 37 CFR 1.14 to grant a foreign IP office access to an unpublished U.S. patent

application. With this grant of authority, the Office may provide the U.S. patent application-as-filed or the requested file contents, such as information and documents, from the U.S. patent application to the foreign IP office on behalf of the applicant. Previously, applicants used former 37 CFR 1.14(h) to authorize the Office to allow a foreign IP office participating in a bilateral or multilateral priority document exchange agreement access to an unpublished U.S. priority application-as-filed. Former 37 CFR 1.14(h), however, did not contain a specific provision by which an applicant could authorize the Office to provide a foreign IP office access to an unpublished U.S. patent application's file contents. As a result, U.S. applicants, unprompted by the rules, found it necessary to provide written authority for access by a foreign IP office to an unpublished application's contents in accordance with 37 CFR 1.14(c) in order to satisfy a requirement for information by the foreign IP office.

General Discussion of the Changes to 37 CFR 1.14(h): The Office is revising 37 CFR 1.14(h) to include a specific provision by which an applicant can authorize the Office to give a foreign IP office access to all or part of the file contents (as opposed to a copy of the application-as-filed) of an unpublished patent application, including search results, to satisfy a foreign IP office requirement for information in a counterpart application filed by a U.S. applicant. The changes to 37 CFR 1.14(h) consolidate the provisions by which applicants can authorize the Office to give access to an unpublished application-as-filed or its file contents to a foreign IP office, while also clarifying for applicants the provision of 37 CFR 1.14 under which such access authorization can be provided. The final rule changes will further serve as a reminder of the opportunity for applicants to grant the

Office the authority to provide a foreign IP office with access to file contents of an unpublished U.S. patent application.

Any information concerning an unpublished application or documents from an unpublished application will only be shared in accordance with the authority provided by applicant and in accordance with the terms of an agreement between the Office and respective foreign IP offices. The Office is not requiring any fee for this service. In addition, sharing of information and documents would be limited to those foreign IP offices where applicant has filed a counterpart application and provided written authority to give a foreign IP office access to all or part of the file contents of an unpublished U.S. application.

The changes to 37 CFR 1.14(h) emphasize the Office's continued support of work sharing efforts between IP offices to increase the quality of issued patents, as well as its commitment to assist in reducing the expenditure of resources of its applicants when complying with the requirements of a foreign IP office in a counterpart application.

Revision to Application Data Sheet Form: In addition to the final rule changes, the Office is revising the application data sheet (ADS) form, PTO/AIA/14 ("the revised ADS form"). The revised ADS form includes separate access authorizations for the PDX program and for the program by which U.S. search results are delivered to the European Patent Office (EPO). The ADS form may be modified in the future to include access authorizations for new work sharing initiatives.

In contrast to the previous version of the ADS form, the revised ADS form includes an “opt-out” check box for each access authorization and not an “opt-in” check box.

Therefore, when an “opt-out” check box for a specific authorization is selected, the Office would not provide access to the contents of the application identified in the authorization.

The revised ADS form will make it easier for applicants to give the necessary authorization for access to an application, as well as afford an applicant the opportunity to inform the Office that the required authority to allow a foreign IP office specific access to an application has not been given. The “Authorization to Permit Access” section containing an opt-in check box for the PDX program in the previous version of the ADS form will be replaced by the “Authorization or Opt-Out of Authorization to Permit Access” section in the first release of the revised ADS form, which is intended to contain two subsections. The first subsection will contain the authorization to permit access to the application-as-filed (the PDX program) and the authorization to permit access to the search results by the EPO. The second subsection will contain the corresponding “opt-out” check box for each authorization in the first subsection.

Appropriate authorization language for access in any ADS generated by applicant must be the same as the authorization language provided in the Office’s revised ADS form. Use of the same language will permit the Office to readily recognize that applicant has given the necessary authorization. If an applicant-generated ADS does not include the

required authorization language for access by a foreign IP office, the ADS will be interpreted as not providing the authorization necessary to give a foreign IP office access.

The submission of a properly signed revised ADS form with the appropriate authorization language on filing of the patent application under 35 U.S.C. 111(a) would be a specific act authorizing access. In addition to an application filed under 35 U.S.C. 111(a), if an ADS is present upon the initial submission of a patent application under 35 U.S.C. 371, the submitted ADS containing authorization would be a specific act authorizing access. Where a revised ADS form, including the authorization language for access by foreign IP office(s) and signed in accordance with 37 CFR 1.14(c) and 1.33(b), has been submitted with an application, the Office would give the foreign IP office(s) access to the contents in accordance with the specific authorization language, upon request of the foreign IP office.

If, however, applicant files a corrected ADS form (i.e., PTO/AIA/14) or a corrected applicant-generated ADS that was not submitted with an application, the authorization for access section will not be reviewed as any changes concerning authorization for access may not be readily apparent to the Office. Instead, applicants must use forms PTO/SB/39 and PTO/SB/69 (or an applicant-generated equivalent), as appropriate, to give or rescind authorization for access after the filing of the application. Forms PTO/SB/39 and PTO/SB/69 will be revised to include opt-in and opt-out check boxes for giving and rescinding the respective authorizations for access after the filing of an application. These two forms can be used in all applications, regardless of their filing dates.

Therefore, a revised ADS form used to correct or update application data would only need to be signed in accordance with 37 CFR 1.33(b) because the authorization for access section is not effective if the revised ADS form is not submitted with the application.

To avoid duplicative processing, the Office is removing the opt-in check box and associated authorization language for the PDX program from the inventor's oath or declaration form PTO/AIA/08 (for applications filed on or after September 16, 2012). Form PTO/SB/39 for the PDX authorization and Form PTO/SB/69 for the search results to the EPO authorization will remain available for applicants that do not use an ADS or have selected the check boxes for opting out of specific authorizations for access by a foreign IP office on the revised ADS form submitted with the application, but later decide to give a foreign IP office access to the application.

The changes to the Office's ADS form PTO/AIA/14 should reduce those instances where an applicant inadvertently fails to provide the authorization necessary to participate in PDX (by not selecting the opt-in check box for priority document exchange authorization on the previous version of the PTO/AIA/14 form submitted with the application) and, as a result, must expend resources to obtain and file a copy of a U.S. priority document with a foreign IP office. Similarly, this approach will help eliminate those instances where an applicant inadvertently fails to give the Office authority (by filing the former version of form PTO/SB/69) to provide the EPO with the search results from an unpublished U.S. priority application and, as a consequence, must expend resources to file the results with the EPO.

If applicant has not provided proper written authority for access, the Office will not deliver an unpublished priority document or file contents of an unpublished application to a foreign IP office, even where a counterpart application has been filed. As discussed above, the revised ADS form would need to be executed in accordance with 37 CFR 1.33(b), and if there is written authority for any access by a foreign IP office, the revised ADS form also must be executed in accordance with 37 CFR 1.14(c). Applicants should be aware of the differences in signature requirements under 37 CFR 1.33(b) and under 37 CFR 1.14(c). For example, under 37 CFR 1.33(b) in applications filed on or after September 16, 2012, the following individuals can sign:

- A patent practitioner of record;
- A patent practitioner not of record who acts in a representative capacity under the provisions of 37 CFR 1.34; or
- The applicant under 37 CFR 1.42. Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

By contrast, under 37 CFR 1.14(c) in applications filed on or after September 16, 2012, the following individuals can sign:

- The applicant;
- A patent practitioner of record;
- The assignee or an assignee of an undivided part interest;
- The inventor or a joint inventor; or

- A registered attorney or agent named in the papers accompanying the application papers filed under 37 CFR 1.53 or the national stage under 37 CFR 1.495, if a power of attorney has not been appointed under 37 CFR 1.32.

If the revised ADS form submitted with an application is not signed in accordance with the relevant rules, then applicant has not provided written authority for access by a foreign IP office to an application. As can be seen by a comparison of the individuals listed in both 37 CFR 1.33(b) and 37 CFR 1.14(c), in most instances an individual listed in 37 CFR 1.33(b) that can sign the revised ADS form can also give access to the application. For example, a patent practitioner of record can sign under both of these regulations. However, if a power of attorney has been appointed under 37 CFR 1.32, which was effective on filing, and a patent practitioner not of record who acts in a representative capacity under the provisions of 37 CFR 1.34 signs the revised ADS form that is submitted with the application, the Office will not recognize that the applicant has provided written authority for access in the revised ADS form. Where forms PTO/SB/39 for PDX authorization and PTO/SB/69 for search results to the EPO authorization are used instead of the revised ADS form, these forms must still be executed in accordance with 37 CFR 1.14(c) even though written authority is provided for under 37 CFR 1.14(h) as amended by this final rule.

The transaction of sharing documents and information from a U.S. application with a foreign IP office has several built in safeguards to ensure that only authorized sharing occurs. For example, in order for a foreign IP office to receive information about a U.S.

application, the Office requires that the foreign IP office expressly identify the U.S. application number, along with other elements of bibliographic data for each U.S. application in its request, to ensure that only information pertaining to the correct U.S. application will be provided to the foreign IP office. Once the application is properly identified, the Office will then determine whether the requisite authorization for access exists in the U.S. application. The Office will only share information or other file content from a U.S. application with a foreign IP office when both the correct application is identified and the existence of proper authorization is confirmed. If an unpublished application, which has not been foreign filed, includes an unintended access authorization pursuant to revised 37 CFR 1.14(h), a foreign IP office would not obtain access because it would not have the information necessary to request access to that specific U.S. application.

Further, the U.S. application's filing receipt will indicate whether applicant has provided written authority for access pursuant to 37 CFR 1.14(h). Applicants should inspect the application filing receipt and request a corrected filing receipt if authorization for access under 37 CFR 1.14(h) was incorrectly captured from the revised ADS form or from an applicant-generated ADS filed along with the application. If authorization for access was inadvertently given, a request for rescission of the authorization can be made by filing either the PTO/SB/39 form or the PTO/SB/69 form in each application where the authorization has been recognized by the Office. The Office should be informed of such rescission as early as possible so the Office has time to recognize the request for rescission and act upon it.

Discussion of Specific Rules: The following is a discussion of the amendments to Title 37 of the Code of Federal Regulations, part 1, in this final rule.

Section 1.14: Section 1.14(h)(1) is amended to retain the first sentence of former § 1.14(h)(1) and include the provisions from former § 1.14(h)(3). Section 1.14(h)(1) also is amended to include that the date of filing of the written authority for priority document exchange may be provided to the respective participating foreign IP office, which codifies the practice set forth in the Official Gazette of the United States Patent and Trademark Office (1328 OG 90 (March 11, 2008)). In § 1.14(h)(1), the text added from former § 1.14(h)(3) has been amended to delete the language “indicated in the written authority.” This deleted language is not necessary as written authority for access under former § 1.14(h) and § 1.14(h) as amended in this final rule will result in access being granted to all PDX and WIPO Digital Access Service (DAS) participating foreign IP offices in which a subsequently filed application claims benefit of the earlier filed U.S. application.

Sections 1.14(h)(1)(i) and (ii) also are amended to include the term “bibliographic data” to reflect that “bibliographic data” is used to ensure the correct application-as-filed is being provided to the participating foreign IP office requesting access in any access to the application-as-filed transaction. The term bibliographic data as used in § 1.14(h)(1) covers certain bibliographic data set forth in WIPO standard ST.9 for bibliographic data. The bibliographic data used to confirm that the correct application-as-filed is being

provided may include the patent document identification, filing data, priority data, publication data, data concerning technical information such as patent classification (international or domestic), and the title of the invention.

Section 1.14(h)(2) is revised to include a provision by which an applicant can authorize the Office to grant a foreign IP office access to the file contents of an application where a counterpart application has been filed with a foreign IP office that has imposed a requirement for information on a counterpart application filed with the foreign IP office. The Office would only provide access to the relevant portion or portions of an unpublished U.S. application's file contents necessary to satisfy any requirement for information by the foreign IP office, triggered by the U.S. applicant filing a counterpart application with the foreign IP office. The Office and the foreign IP office would also need to have a bilateral or multilateral agreement for the Office to provide the required information. The agreement would provide for the secure transmission and receipt of any shared information. Section 1.14(h)(2)(i) is amended to include the term "bibliographic data" to reflect that "bibliographic data" is used to ensure the information is from the correct application for which access has been requested by the foreign IP office in any access to the application. The term bibliographic data as used in § 1.14(h)(2) includes the same types of bibliographic data set discussed above with respect to § 1.14(h)(1).

Former 1.14(h)(2) has been moved to § 1.14(h)(3).

Section 1.14(h)(3) is amended to indicate that written authority provided under §§ 1.14(h)(1) and (h)(2) should be submitted before the filing of any subsequent foreign application in which priority is claimed to the application. Section 1.14(h)(3) also is amended to indicate that the written authority under §§ 1.14(h)(1) and (2) must include the title of the invention (§ 1.72(a)), comply with the requirements of § 1.14(c), and must be submitted on an application data sheet (§ 1.76) or on a separate document (§ 1.4(c)).

Section 1.19: Section 1.19(b)(1)(iv) is amended to indicate there is no fee for providing a foreign IP office with a copy of either an application-as-filed or patent related file wrapper and contents pursuant to a bilateral or multilateral agreement (see § 1.14(h)).

Comments and Responses to Comments: The Office published a notice of proposed rulemaking on July 11, 2014, proposing to amend its rules of practice to include a specific provision by which an applicant can authorize the Office to give a foreign intellectual property (IP) office access to all or part of the file contents of an unpublished U.S. patent application in order to satisfy a requirement for information imposed on a counterpart application filed with the foreign IP office. See [Changes to Facilitate Applicant's Authorization of Access to Unpublished U.S. Patent Applications by Foreign Intellectual Property Offices](#), 79 FR 40035 (July 11, 2014). The Office received comments from two intellectual property organizations, a patent practitioner, and a member of the public in response to this notice of proposed rulemaking. Three comments were very positive and supported the proposed changes. One comment opposed the proposed changes. Comments that supported the proposed changes are not

discussed. The remaining comments and the Office's responses to those comments follow:

Comment 1: Three comments suggested removing the language “indicated in the written authority” from “all foreign intellectual property offices indicated in the written authority” in proposed §1.14(h)(2). Two comments noted that this specific language was excluded from proposed §1.14(h)(1) relating to access to an application-as-filed. One comment asserted that this language may be inconsistent with the statement in the notice of proposed rulemaking that the written authority to provide access to this information would be provided on an “opt-out” basis on the ADS and that any such provision on the ADS would not include a list of foreign intellectual property offices. One comment questioned whether an applicant will have to specify in advance all foreign IP offices that will receive pre-publication information.

Response: Section 1.14(h)(2) as adopted in this final rule does not include the language “indicated in the written authority.” Each written authorization on the revised ADS form will indicate either the specific foreign IP office(s) that is being granted access to the associated pre-publication information or that all the foreign IP offices participating with the Office in a particular work sharing initiative program are being granted access to pre-publication data.

Comment 2: One comment stated that access to pre-publication documents under the proposed rule change facilitates implementation of global projects like the IP5's Global

Dossier project. Another comment raised concerns that the proposed rule change will require all of the IP5 Patent Offices to have mutual agreements with each other in order to implement the Global Dossier to cover pre-publication information and suggested that the Office review this requirement in light of the prospective Global Dossier System.

Response: The sharing of documents or information from unpublished U.S. applications between the Office and any foreign IP office has historically required a mutual agreement to cover these shared information or documents. An agreement is needed to ensure that the parties are aware of their obligations to one another (e.g., keeping pre-publication information in confidence). Additionally, as stated in the notice of proposed rulemaking, the Office and the foreign IP office would need to have a bilateral or multilateral agreement that provides for the secure transmission and receipt of any shared information. 79 FR at 40038. Furthermore, the agreement serves as notice to the public regarding what application information (with applicant's consent if the application is unpublished) the Office and other foreign IP office have agreed to share with one another to thereby reduce the resources applicants must expend to comply with any IP office's requirements for information imposed when a counterpart application is filed with a foreign IP office. Currently, the Office will not provide any information or documents from an unpublished U.S. application to a foreign IP office if the Office does not have an agreement to provide such information or documents. Should the Office determine that sharing documents from an unpublished U.S. application with other IP offices in the absence of an agreement would be beneficial, the Office would engage the public to seek its input.

Comment 3: One comment requested seeing the proposed new ADS form before actual implementation of the final rule to be sure that the language in the ADS meets the needs of our applicants.

Response: Due to IT constraints, the EFS-Web based version of the revised ADS form had to be finalized well in advance of the publication of the final rules. The public will have an opportunity to comment on the first release of the revised ADS form. The Office will consider these comments for the next release of the form.

Comment 4: One comment asserted that the proposed rule change is based upon the assumption that a specific authority is required from an applicant in order to send out pre-publication information to a foreign IP office where applicant has filed an application and that the Office should reconsider this assumption. The comment further asserted that once an applicant files an application in a foreign IP office, applicant inherently agrees to the rules and requirements of that foreign IP office. Accordingly, the comment suggests that the Office does not need a separate authorization to either send a priority document or pre-publication information to that foreign IP office. Therefore, the comment requested that the Office reconsider the need for any authorization for access in this circumstance. The comment stated that if the Office adopts this position, then the entire authorization section from the ADS can be removed and a filing of an application in a foreign IP office by an applicant can serve as authorization for access to send priority documents and/or pre-publication information to that foreign IP office(s).

Response: After due consideration of the comment, the Office has decided to not adopt the position expressed in the comment. The written authority requirement is in accord with 35 U.S.C. 122(a), and consistent with current Office policy, practice, and procedure regarding access. Therefore, the Office is retaining the requirement for written authority from an applicant for access to the file contents of an unpublished application.

Comment 5: One comment opposed the proposed rule and asserted that the proposed rule will do great harm to independent inventors, university technology licensing organizations, small entity inventors, and overall U.S. development. Specifically, the comment alleged that the majority of foreign patent offices are integral parts of their national industrial development efforts and serve as collectors of information about U.S. technologies and that permitting these foreign governments to have access to unpublished patent applications will significantly undermine U.S. inventors and U.S. innovation.

Response: Neither the proposed rule nor the final rule establish a new program for providing unpublished applications to foreign governments. Under the final rule, the Office would only provide information to a foreign IP office where the applicant has already filed a counterpart application with that foreign IP office coupled with applicant's written authorization for access in the U.S. application. Specifically, the Office would be satisfying a duty placed on a U.S. applicant by the foreign IP office due to the U.S. applicant filing a counterpart application with that foreign IP office. For example, the Office, after receiving applicant's written authorization for access, would provide the

foreign IP office where the counterpart application was filed the required information, along with sufficient bibliographic data to confirm that the correct U.S. and foreign counterpart applications have been matched. Finally, the Office will not deliver an unpublished priority document, file contents of an unpublished application, including information about an unpublished application, to a foreign IP office, even where a counterpart application has been filed, if applicant has not provided proper written authorization for access.

Rulemaking Considerations:

A. Administrative Procedure Act: This rulemaking amends the rules of practice to include a specific provision by which an applicant can authorize the Office to give a foreign IP office access to all or part of the file contents of an application, and thus pertains solely to the process for an applicant to provide a limited waiver of confidentiality under 35 U.S.C. 122(a) to allow a counterpart IP office access to all or part of the file contents of an application. Therefore, the changes in this final rulemaking involve rules of agency practice and procedure and/or interpretive rules. See *Bachow Commc'ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims). The Office received no public comment on this section or any of the sections under the Rulemaking Considerations.

Accordingly, prior notice and opportunity for public comment are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))). The Office, however, published proposed changes for comment as it sought the benefit of the public’s views on the Office’s proposed changes to include a

specific regulatory provision by which an applicant can provide the Office with authority to give a foreign IP office access to all or part of the file contents of an application.

B. Regulatory Flexibility Act: For the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes in this final rule will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

This rulemaking amends the rules of practice to include a specific provision by which an applicant can authorize the Office to give a foreign IP office access to all or part of the file contents of an application. This rulemaking consolidates and clarifies in one place—37 CFR 1.14(h)—existing procedures in both 37 CFR 1.14(c) and (h) relevant to authorizing the Office to provide a foreign IP office access to all or part of the file contents of an application or to an application-as-filed. Moreover, the use of the revised forms discussed (PTO/AIA/14; PTO/SB/39; and PTO/SB/69) will provide applicants that wish to provide a foreign IP office access to their applications greater ease and efficiency in transmitting the requisite authorization. The changes in this rulemaking do not require any applicant to provide the Office with this authority. There is no fee for this service. Therefore, the changes in this final rule will not have a significant economic impact on a substantial number of small entities.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this final rule are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this final rule is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this final rule do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

O. Paperwork Reduction Act: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501-3549). The collection of information involved in this rulemaking has been reviewed and previously approved by OMB under OMB Control Numbers 0651-0031 and 0651-0032. The Office is not resubmitting an information collection package to OMB for its review and approval because the changes in this rulemaking do not change patent fees or change the information collection requirements (the estimated number of respondents, time per response, total annual respondent burden hours, or total annual respondent cost burden) associated with the information collections approved under OMB Control Numbers 0651-0031 and 0651-0032. The revised ADS form (PTO/AIA/14) as well as the PTO/SB/39 and PTO/SB/69 forms have already been reviewed and approved by OMB, or have been

determined to not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act, unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

For the reasons stated in the preamble, 37 CFR part 1 is amended as follows:

PART 1--RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2).

2. Section 1.14 is amended by revising paragraph (h) to read as follows:

§ 1.14 Patent applications preserved in confidence.

* * * * *

(h) Access by a Foreign Intellectual Property Office. (1) Access to an application-as-filed may be provided to any foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), if the application contains written authority granting such access. Written authority provided under this paragraph (h)(1) will be treated as authorizing the Office to provide the following to all participating foreign intellectual property offices in accordance with their respective agreements with the Office:

(i) A copy of the application-as-filed and its related bibliographic data;

(ii) A copy of the application-as-filed of any application the filing date of which is claimed by the application in which written authority under this paragraph (h)(1) is filed and its related bibliographic data; and

(iii) The date of filing of the written authorization under this paragraph (h)(1).

(2) Access to the file contents of an application may be provided to a foreign intellectual property office that has imposed a requirement for information on a counterpart application filed with the foreign intellectual property office where the foreign intellectual property office is a party to a bilateral or multilateral agreement with the Office to provide the required information from the application filed with the Office and the application contains written authority granting such access. Written authority provided under this paragraph (h)(2) will be treated as authorizing the Office to provide

the following to all foreign intellectual property offices in accordance with their respective agreements with the Office:

(i) Bibliographic data related to the application; and

(ii) Any content of the application file necessary to satisfy the foreign intellectual property office requirement for information imposed on the counterpart application as indicated in the respective agreement.

(3) Written authority provided under paragraphs (h)(1) and (h)(2) of this section must include the title of the invention (§ 1.72(a)), comply with the requirements of paragraph (c) of this section, and be submitted on an application data sheet (§ 1.76) or on a separate document (§ 1.4(c)). The written authority provided under these paragraphs should be submitted before filing any subsequent foreign application in which priority is claimed to the application.

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3. Section 1.19 is amended by revising paragraph (b)(1)(iv) to read as follows:

§ 1.19 Document supply fees.

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(b) * * *

(1) * * *

(iv) If provided to a foreign intellectual property office pursuant to a bilateral or multilateral agreement (see § 1.14(h)): \$0.00.

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Dated: October 21, 2015.

Michelle K. Lee,

*Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office.*

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